

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: LDW Group, Inc.  
 Mark: COCK CONTROL  
 Serial Number: 86270103  
 Examining Attorney: Allison Holtz  
 Law office: USPTO – TMO Law Office 111

### 1.0 RESPONSE TO OFFICE ACTION

This Response to Office Action is offered in reply to the Office Action taken on September 3, 2015 regarding Serial Number 86270103 (the “Mark”).

In the Office Action, the PTO noted a refusal to register under 15 U.S.C. § 1052(a). Applicant respectfully disagrees with the finding that the Mark is “immoral” and “scandalous,” and offers argument and evidence in support of that position. It is telling here that the Examiner apparently did not consider the mark to be “immoral” or “scandalous” on initial examination, nor did the general public find anything objectionable about the Mark when it was published in the Official Gazette for opposition. Rather, it took the Examiner an entire year<sup>1</sup> to

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<sup>1</sup> The Examiner issued an initial refusal on 15 U.S.C. § 1052(e)(1) grounds on August 25, 2014. Under normal circumstances, the Mark would have been granted registration on the Principal Register by the time of issuance of this second Office Action.

come to the conclusion that the Mark is so “shocking” to the average person’s sensibilities that it should be denied registration. Making this renewed sense of offense at the Mark even less credible is the fact that the initial refusal issued on August 25, 2014 was based on the argument that the Mark was allegedly *merely descriptive and/or generic* of Applicant’s phone sex services. It strains credulity to assert that a mark is so commonplace as to be generic, then turn around and assert that it is so offensive that the general public should be shielded from it.

Applicant disputes the Examiner’s finding of immorality and scandalousness under § 2(a), and requests registration of the Mark on the Principal Register without further delay. In the alternative, the Mark may be registered because the prohibition on immoral and scandalous marks violates Applicant’s rights under the First Amendment and can no longer be enforced.

## **2.0 Argument**

### **2.1. The Mark is Neither Immoral nor Scandalous**

In issuing refusal of Applicant’s mark, the Examiner focused on the word “Cock” in “Cock Control”, where the application is for:

Entertainment in the nature of live performances by telephone actors; Entertainment services, namely, providing a website at which the general public can receive advice from an individual or entity concerning happiness, such advice being for entertainment purposes only.

Relying on dictionary definitions, the Examiner determined that the word “Cock” is a vulgar word for “penis.” The word “Cock” has meant “penis” potentially as far back as the 1300s. (See “Cock,” ONLINE ETYMOLOGY DICTIONARY, attached as **Exhibit 1**.<sup>2</sup>) Over seven hundred years of use later, the word “cock” is not automatically vulgar.

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<sup>2</sup> Available at: <[http://www.etymonline.com/index.php?term=cock&allowed\\_in\\_frame=0](http://www.etymonline.com/index.php?term=cock&allowed_in_frame=0)> (last accessed 22 January 2016).

Applicant does not dispute that COCK **can** mean “penis.” Further, Applicant does not dispute that some dictionary editor might titter at the term, and thus place the label “vulgar” to the side of it – but that unnamed, unidentified dictionary editor is not “the public.” In fact, the Federal Circuit has made it clear that a dictionary editor's opinion is not dispositive. The court in *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1373 (Fed. Cir. 1994) found there to be an

inherent fallibility in defining the substantial composite of the general public based solely on dictionary references. While a standard dictionary may indicate how the substantial composite of the general public defines a particular word, the accompanying editorial label of vulgar usage is an arguably less accurate reflection of whether the substantial composite considers the word scandalous. Such labels are subject not only to differences in opinion among the respective publication staffs of particular dictionaries, but also to the potential anachronism of those opinions.

Logic and the Federal Circuit agree -- dictionary editors do not determine whether something is “immoral” or “calling out for condemnation.” The public makes that decision. Normally, in such cases, we do not have the prior knowledge of how the public feels about such a mark, and we are forced to guess. However, in this case, we have empirical evidence of how much the public actually did *call out for condemnation* – not at all. Not a peep. Not a letter of protest. Not a challenge of any kind. The mark proceeded to publication and, despite the Examiner's determination that the public would find the mark calling out for condemnation, the public met this mark with tacit approval.

### 2.1.1. Existing Marks Support a Finding of Registrability

The Examiner will note that the mark must be examined in the context of the current attitudes of the day. See *In re Mavety*, 33 F.3d 1367. It is under the lens of the moral values and mores of contemporary society in which the word must be viewed. See *In re Thomas Laboratories, Inc.*, 189 USPQ 50, 52 (TTAB 1975) (“[I]t is imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable.”). Looking at contemporary attitudes, it is notable that the PTO has approved the following marks containing the use of “Cock” in the penile sense:

- Big Cock Ownership Club, Reg. No. 486921, Dec. 15, 2015, attached as **Exhibit 2**.
- Big Cock Ranch, Reg. No. 4677436, Jan. 27, 2015, attached as **Exhibit 3**.
- Cock Grease, Reg. No. 4666248, Jan. 6, 2015,<sup>3</sup> attached as **Exhibit 4**.
- Big Red Coq, Reg. No. 4834334, Oct. 20, 2015, attached as **Exhibit 5**.
- Cock Diesel, Reg. No. 4720288, Apr. 14, 2015, attached as **Exhibit 6**.
- One Foot Cock, Reg. No. 4544038, June 3, 2014, attached as **Exhibit 7**.
- Cock Rub, Reg. No. 4258088, Dec. 11, 2012, attached as **Exhibit 8**.
- Long Coq, Reg. No. 4488732, Feb. 25, 2014, attached as **Exhibit 9**.
- Fat Coq, Reg. No. 4112430, Mar. 13, 2012, attached as **Exhibit 10**.
- Big Coq, Reg. No. 4112429, Mar. 13, 2012, attached as **Exhibit 11**.
- CockSox, Reg. No. 4123962, Apr. 10, 2012, attached as **Exhibit 12**.

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<sup>3</sup> The registrant of this mark is “Cock N’ Kitten, LLC.” As the latter “Kitten” is a synonym for “vagina,” the business name is clearly intended to mean “penis and vagina.” And it has been registered since January 2015 with no calamity from heaven, hell, nor earth coming to rest upon us as a result of the registration.

- Commando Cock, Reg. No. 2342145, Apr. 18, 2000,<sup>4</sup> attached as **Exhibit 13**.

Despite this long history of the USPTO approving of “Cock marks,” for some reason, the Examiner so disapproves of Applicant’s commercial speech that the decision was made, after publication, that this mark should be disfavored, when there is no material difference between this mark and those which were previously approved – except, perhaps, Applicant’s mark is not so obviously referring to a penis as “COCK GREASE” or “COCK COMMANDO” is.

If “COCK” were vulgar and society disapproved of it, the University of South Carolina would certainly not sell as much merchandise as it does emblazoned with the word “GAMECOCKS.” (See South Carolina Gamecocks Shop web site “Men’s T-Shirts” page, attached as **Exhibit 14**.<sup>5</sup>) Just last year, that bastion of propriety, the English Parliament, featured a speech by MP Penny Mordaunt in which she used the word “Cock” six times in a speech based on a bet, for which she was then awarded “Speech of the Year” by The Spectator. See Fraser Nelson, “Spectator Parliamentarian of the Year 2014: the winners,” THE SPECTATOR, 27 November 2014, attached as **Exhibit 15**.<sup>6</sup> The current attitudes of the day, then, suggest that “COCK” is not “scandalous.”

### **2.1.2. In Re Fox is Inapplicable**

The Examiner relied upon *In re Fox*, 702 F.3d 633, 638 (Fed. Cir. 2012) to determine that Applicant’s use of the mark was vulgar. However, that case involved a chocolate lollipop called a “cock sucker,” deemed a reference to

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<sup>4</sup> This registration is for “electric massage apparatus, namely, vibrators.” This is as phallic as a mark can get, and yet for over a decade and a half no one, not even the Examiner assigned to that application, has found anything objectionable about the mark.

<sup>5</sup> Available at: <[http://shop.gamecocksonline.com/COLLEGE\\_South\\_Carolina\\_Gamecocks\\_Mens\\_T-Shirts](http://shop.gamecocksonline.com/COLLEGE_South_Carolina_Gamecocks_Mens_T-Shirts)> (last accessed January 22, 2016).

<sup>6</sup> Available at: <<http://blogs.spectator.co.uk/coffeehouse/2014/11/spectator-parliamentarian-of-the-year-2014-the-winners/>> (last accessed January 22, 2016).

the act of fellatio. The term “Cock sucker” has a history of being used as a pejorative. It is featured in Supreme Court opinions such as *FCC v. Pacifica Found.*, 438 U.S. 726, 751-752 (U.S. 1978)<sup>7</sup> and *Bd. of Educ. v. Pico*, 457 U.S. 853, 901 (U.S. 1982). “Cock control,” on the other hand, has no such history.<sup>8</sup> While applicant does not concede that COCK SUCKER was properly refused registration either, especially in light of *In re Tam*, 2015 U.S. App. LEXIS 22593 (Fed. Cir. Dec. 22, 2015), it is distinguishable from COCK CONTROL. Nevertheless, in *Fox*, the word “cock” alone was not deemed per se un-registrable.

Indeed, a recent (non precedential) decision by the TTAB highlights the more modern way of looking at these types of marks. See *In re Engine 15 Brewing Co., LLC*, 2015 TTAB LEXIS 454 (Oct. 29, 2015). In considering the mark NUT SACK DOUBLE BROWN ALE, the TTAB reviewed the use of “clinical” terms for certain genitalia, as well as a “relevant marketplace” analysis, and came to the conclusion that the aforementioned mark could proceed to registration. See *id.* at \*14-15. With respect to its first point of analysis, the TTAB observed

that many slang terms come into the lexicon because the formally correct, clinical word for the thing itself is deemed uncomfortably potent. This seems to be particularly true with respect to parts of the human body, in which case speakers adopt the slang terms precisely because they seem less intense, less indelicate, than the formally correct or technical terminology.

*Id.* at \*14.

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<sup>7</sup> Specifically, the Supreme Court found comedian George Carlin's string of expletives “shit, piss, cunt, fuck, cocksucker, motherfucker, tits” to be objectionable. Carlin acknowledged that the penultimate term was redundant, but kept it in because it made the last few words flow better.

<sup>8</sup> The only reported decision found via a Lexis-Nexis search on “cock control” was *Salsberry v. Archibald Plumbing & Heating Co.*, 587 S.W.2d 907, 911 (Mo. Ct. App. 1979), referring to the “gas cock” in plumbing.

**2.1.3. Even if a Substantial Composite of the General Public Would Find the Mark Immoral or Scandalous, It is Not Immoral or Scandalous in the Relevant Marketplace.<sup>9</sup>**

The Examiner incorrectly looked to the wrong market in determining that the mark is vulgar. The Examiner set forth the relevant standard as:

A mark is scandalous when the evidence demonstrates that a substantial composite of the general public (although not necessarily a majority) would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace. See *In re Fox*, 702 F.3d at 635, 105 USPQ2d at 1248 (quoting *In re Mavety Media Grp. Ltd.*, 33 F.3d at 1371, 31 USPQ2d at 1925-26); *In re The Boulevard Entm't, Inc.*, 334 F.3d 1336, 1340, 67 USPQ2d 1475, 1477 (Fed. Cir. 2003); TMEP §1203.01.

However, the Examiner did not look at the relevant marketplace – instead, she looked at the marketplace as a whole. The “relevant marketplace” approach is long-embraced in Trademark Law. See *In re Steven Hershey, dba Seaside Graphics*, 6 USPQ2d (BNA) 1470, 1471 (TTAB 1988) (“to determine whether a designation is properly refused as scandalous, the mark must be considered in the context of the marketplace as applied to the goods or services described in the application”). Chocolate lollipops may be intended for general consumption. Adult-oriented websites and telephone entertainment are not. One must purposefully seek out the latter, rather than being found on the shelves of grocers and convenience stores for the former. In the world of adult entertainment, the word “cock” is commonplace.

The TTAB in *In re Engine 15*, 2015 TTAB LEXIS 454 gives the Examiner guidance in reviewing marks under the “relevant marketplace” analysis. The

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<sup>9</sup> See *In re Mavety*, 33 F.3d at 1371; see also *In re Wilcher Corp.*, 40 USPQ2d 1929, 1930 (TTAB 1996); and see *In re Hershey*, 6 USPQ2d 1470 (“to determine whether a designation is properly refused as scandalous, the mark must be considered in the context of the marketplace as applied to the goods or services described in the application”).

TTAB recognized, in analyzing NUT SACK, that the beer drinking public would have a very different impression of the term than the public at large:

[W]e find that some terms, such as “Nut Sack” appearing within “Nut Sack Double Brown Ale” may seem somewhat taboo in polite company, but are not so shocking or offensive as to be found scandalous within the meaning of the statute.

*Id.* at \*14.

In analyzing the mark further, the TTAB noted that since beer is an “adult beverage, the consumption of which is commonly associated with the relaxation of inhibitions” then “beer drinkers can cope with the Applicant’s mark without suffering meaningful offense.” *Id.* at \*14-15. Similarly, in this case, phone sex services are adult-oriented services, the use of which is commonly associated with “the relaxation of inhibitions” as well. If beer drinkers can cope with NUT SACK, then phone sex customers most certainly can handle COCK CONTROL without sustaining back injuries as they fall onto their fainting divan, or neck injuries as they clutch their pearls (obviously with only one hand).

## **2.2. Section 2(a) Violates the Unconstitutional Conditions Doctrine and Cannot Be Enforced**

### **2.2.1. *In re McGinley is Dead***

Since the ‘80s, the only court to provide any degree of analysis in affirming the constitutionality of Section 2(a) is *In Re McGinley*, 660 F.2d 481 (C.C.P.A 1981). The court there flippantly concluded that Section 2(a) does not implicate an applicant’s First Amendment rights because the statute does not prevent one from using a mark, overlooking the fact that it conditions significant federal benefits on the concession of constitutional rights. *Id.* at 484. Every subsequent case affirming Section 2(a) has uncritically cited to this decision. See *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012); *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1343



(Fed. Cir. 2003); *In re Mavety Media Grp.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994). However, as of December 2015, more than thirty years later, that trend is dead.

The Federal Circuit in *In re Tam*, 2015 U.S. App. LEXIS 22593 (Fed. Cir. Dec. 22, 2015) unambiguously overruled *In re McGinley* and struck down the “disparaging” portion of Section 2(a), finding that it was a content and viewpoint-based restriction on speech that did not pass strict scrutiny, and that it ran afoul of the “unconstitutional conditions” doctrine. *Id.* at 56. While the court did not address the “immoral” and “scandalous” portion of Section 2(a), it “overrule[d] *In re McGinley* . . . and other precedent insofar as they could be argued to prevent a future panel from considering the constitutionality of other portions of § 2 in light of the present decision.” *Id.* at \*11 n.1. Because *In re McGinley* and its progeny are no longer good law, Section 2(a) no longer has a constitutional leg to stand on.

The PTO has even explicitly recognized that Section 2(a), in its entirety, is no longer good law in light of *In re Tam*. (See January 21, 2016 letter from Joshua Salzman to U.S. Department of Justice regarding *In re Brunetti*, No. 2015-1109, attached as **Exhibit 16**.) In a letter brief to the Department of Justice in the case of *In re Brunetti*, No. 2015-1109, the PTO admitted that it does “not believe, given the breadth of the Court’s *Tam* decision and in view of the totality of the Court’s reasoning there, that there is any longer a reasonable basis in this Court’s law for treating [the “disparagement” and “immoral” and “scandalous” provisions of Section 2(a)] differently.” (*Id.* at 2.) It further stated that it does “not believe that Section 2(a)’s prohibition on registration of scandalous and immoral marks can withstand challenge under the current law of this Circuit.” (*Id.* at 3.) To persist in the Examiner’s refusal to register Applicant’s mark on

Section 2(a) grounds would be to disregard the state of the law, the First Amendment, and common sense.

### **2.2.2. Trademarks Are Protected Speech Under the First Amendment**

Although the Federal Circuit's decision in *In re Tam* is enough by itself to show that Applicant's mark should proceed to registration, it is worthwhile to explain precisely why Section 2(a) is unconstitutional.

While trademarks have traditionally been considered commercial speech, which receives a slightly lower level of protection than other forms of speech under the First Amendment, the *In re Tam* court found that marks frequently communicate an expressive, rather than purely commercial, message, and thus receive full First Amendment protection. See *In re Tam*, 2015 U.S. App. LEXIS 22593 at \*30. This means that the Government must satisfy strict scrutiny, which it could never have any hope of doing. See *id.* But even if trademarks were not expressive speech entitled to full First Amendment protection, “[m]inimal information, conveyed in the context of a proposal of commercial transaction suffices to invoke the protection for commercial speech articulated in *Central Hudson*.” *Bad Frog Brewery v. New York State Liquor Authority*, 134 F.3d 87, 97 (2d Cir. 1998). The Supreme Court in *Central Hudson* determined that where speech is protected, the court must determine “whether the asserted government interest is substantial[,] . . . whether the regulation directly advances the government interest asserted, and whether it is not more extensive than is necessary to serve that interest.” *Central Hudson Gas & Electric v. Public Service Commission*, 447 U.S. 557, 566 (1980). Section 2(a) violates the First Amendment because it is an arbitrary viewpoint-based restriction on protected speech that does not advance any substantial government interest, as the *In re Tam* court found. See *In re Tam*, 2015 U.S. App. LEXIS 22593 at \*85

The First Amendment protects “[a]ll ideas having even the slightest redeeming social importance.” *Roth v. United States*, 354 U.S. 476, 484 (1957). This includes commercial speech, which proposes a commercial transaction. See *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council*, 425 U.S. 748, 762 (1976). Trademarks help consumers identify the quality of a certain good or service so the consumer can choose whether or not to repeat their purchasing experience. “Society [] has a strong interest in the free flow of commercial information, both because the efficient allocation of resources depend upon informed consumer choices,” and because such information is of general public interest. *Id.* Thus, protection of trademarks supports not only the speaker, but also the consumer’s right to “receive information and ideas.” See *Virginia State Bd.*, 425 U.S. at 756. The “immoral” and “scandalous” provision of Section 2(a), of course, does nothing to advance this goal of the Lanham Act.

In *Virginia State Bd.*, the Virginia Consumer Council argued for limiting price advertising for pharmacies because it had an interest in maintaining professionalism in the pharmacy industry. The Court denied this argument, stating that any pharmacist acting against his customers’ interest would not only lose his license, but customers would likely stop going to that pharmacist. *Id.* The First Amendment “is designed and intended to remove governmental restraints from the arena of public discussion, putting the decision as to what views shall be voiced largely into the hands of each of us.” *Cohen v. California*, 403 U.S. 16 (1971). Trademarks are one of the simplest places to apply this kind of market-based control.

Like consumers who choose a pharmacist who has their interests in mind, consumers who do not approve of the name or message sent by a trademark will refrain from patronizing that company. Those consuming products or

services with so-called immoral or scandalous marks are no different. For example, the pornography-consuming public might be shocked and scandalized at a website called CUMFIESTA. See *In re RK Netmedia, Inc.*, 2009 TTAB LEXIS 389 (T.T.A.B. May 21, 2009) (affirming refusal of CUMFIESTA and CUMGIRLS for adult oriented Internet material). If a competitor sold similar goods under the hypothetical mark EFFLUVIA PARTY, and the pornography-consuming public liked the tasteful nature of that name better, then the market would speak to the former – “change your name if you want our money.”

Trademarks provide consumers with information concerning the ideals and philosophical underpinnings of a company. “Advertising, however tasteless and excessive it sometimes may seem, is nonetheless dissemination of information,” and this information can be vital to consumers in determining what companies to purchase from. *Virginia State Bd.*, 425 U.S. at 765. In the aforementioned hypothetical, perhaps pornography purchasers would look at the competing publications and say to themselves “you know, CUMFIESTA has just the right level of whimsy and sexuality for me, that’s what I want.” Why should the government place its finger on the scale simply because someone, somewhere, thinks that someone else might be “shocked?”

Trademark holders and company owners use trade names and businesses to promote their personal views and make those views known to their customers. See e.g. *Burwell v. Hobby Lobby*, 573 U.S.\_\_\_\_, 134 S.Ct. 2751 (2014). In the end, it is the mark holder’s choice to use a mark that may discourage or even alienate certain consumers. Such a decision may even be made for the purpose of scaring away certain customers; promoting a certain viewpoint; to gain notoriety for having a controversial name; or simply because the name has some significance, personally, historically, or otherwise.

Trademarks, including those that may be immoral or scandalous, are speech protected by the First Amendment. Aside from protecting the public from trademarks that are deceptive or concern unlawful activity, the PTO's refusal or revocation of a mark under Section 2(a) and the impairment of the right to enforce the rights under such marks, amounts to a restraint on protected speech that requires substantial justification. No such justification exists here

### **2.2.3. Section 2(a) is a Viewpoint-Based Restriction on Speech**

Section 2(a) is a restriction based on the content of an applicant's trademark. "Content-based laws – those that target speech based on its communicative content – are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests." *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015). Viewpoint-based restrictions, which "target[] the substance of the viewpoint expressed, are even more suspect." *In re Tam*, 2015 U.S. App. LEXIS 22593 at \*22. "The First Amendment requires heightened scrutiny whenever the government creates 'a regulation of speech because of disagreement with the message it conveys.'" *Sorrell v. IMS Health Inc.*, 131 S. Ct. 2653, 2664 (2011) (quoting *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989)). The high burden that the Government must meet in justifying a content-based restriction exists even where the restriction falls short of banning the speech; "[t]he distinction between laws burdening and laws banning speech is but a matter of degree. The Government's content-based burdens must satisfy the same rigorous scrutiny as its content-based bans." *United States v. Playboy Entmt'l Grp. Inc.*, 529 U.S. 803, 812 (2000).

An impossible to quantify “value” to society provided by the mark should not be relevant to the Government’s circumvention of First Amendment protection, as

the commercial marketplace, like other spheres of our social and cultural life, provides a forum where ideas and information flourish. Some of the ideas and information are vital, some of slight worth. But the general rule is that the speaker and the audience, not the government, assess the value of the information presented.

*Edenfield v. Fane*, 507 U.S. 761, 767 (1993).

In *Edenfield*, the Court determined that a rule prohibiting CPAs from engaging in in-person solicitation, as applied, violated the First Amendment, finding that the law threatened access to accurate commercial information. *Id.* at 777. Similarly, § 2(a) restricts consumers’ access to accurate commercial information about the business the trademark is affiliated with, as well as to any additional speech conveyed by the trademark itself. As with anyone exercising their First Amendment rights, trademark holders should be permitted to engage in commercial speech with consumers potentially interested in their products or associated ideas. Mark holders should similarly be permitted to continue those relationships after the mark has been established.

*In re Tam* tells us that trademarks are protected by the First Amendment, and that § 2(a) is a viewpoint-based restriction on such protected speech. Previously, a panel of the Federal Circuit determined that the mark “COCK SUCKER” for rooster-shaped chocolate lollipops was “scandalous” under § 2(a). *In re Fox*, 702 F.3d at 639–40. In *Fox*, the court determined that in addition to satisfying the definitions of scandalous, if a mark has any “vulgar” meaning it is *per se* scandalous. *Id.* at 635. Thus, the court applied § 2(a) to determine whether the “public will assign” a scandalous meaning to the mark even if the

mark is a double entendre. *Id.* at 636. The applicant in *In re Fox* wanted to use the mark “COCK SUCKER” as a joke, playing off the multiple definitions of the words and their literal meaning as applied to her actual product, rooster lollipops. *Id.* By using an exact definition, the court removed all possible humor from the name. One does not look at the mark “Cock sucker” and think “that is quite humorous because it is in reference to ‘one who performs an act of fellatio,’” as the court suggested. See *id.* at 635. Instead, it is inherently humorous because we live in a society with “taboo” statements that are not inherently unacceptable.

In a similar case, noted by the Examiner, the Federal Circuit determined “jack-off” to be an immoral and scandalous term in *In re Boulevard*, despite evidence showing that the term was neither. 334 F.3d 1336 (Fed. Cir. 2003). The court interpreted *In re Mavety Media Group*, 33 F.3d 1367 (Fed. Cir. 1994), to say that dictionary definitions alone were insufficient to determine whether a mark was “scandalous,” except where there is only one pertinent meaning as applied to the trademark at issue. *Boulevard*, 334 F.3d at 1340. The applicants had provided evidence “to show that the term . . . is not immoral or scandalous,” but the court found that the declarations in the record “consist[ed] mainly of the personal opinions of the declarants as to the offensiveness of the term.” *Id.* at 1341. Once it determined that “masturbation” was the definition of the term “jack-off,” the court found the term to be offensive and ignored all evidence to the contrary as “wholly irrelevant.” *Id.* at 1343. The court picked one definition of the term “jack-off,” decided it was “offensive,” and then withheld a federal benefit to the applicant based on the viewpoint towards a sexual topic expressed by the applicant’s trademark. This is not the kind of determination that courts or the PTO make only when feeling especially

authoritarian; this is a determination that *any* trademark examiner *must* make when choosing to refuse registration on § 2(a) grounds. There simply is no viewpoint-neutral, much less content-neutral, way to refuse or revoke registration based on § 2(a).

Because § 2(a) limits this transfer of information based on the viewpoint expressed by a trademark, it regulates protected speech. In light of this, § 2(a) must be “narrowly tailored” to serve a substantial government interest. *Florida Bar v. Went for It, Inc.*, 515 U.S. 618, 632 (1995). It is not.

The *Tam* court wasted no time in concluding that “[i]t is beyond dispute that § 2(a) discriminates on the basis of content” and is invalid on its face. *In re Tam*, 2015 U.S. App. LEXIS 22593 at \*23, n.5. This is an obvious conclusion regarding both the “disparagement” and “immoral” and “scandalous” provisions of the law; the PTO refuses some marks registration based on the words they contain. This decision, and the court’s reasoning therein, establishes that trademarks possess elements of speech beyond merely identifying the source of goods and services; indeed, how could speech that merely identifies the source of goods or services be “vulgar” at all, such that it could offend the sensibilities of the PTO? The only effect of § 2(a) is for the PTO to make a determination that certain terms, which express particular viewpoints about particular subjects, are off-limits. Thus, it is likely that the Federal Circuit, in light of *In re Tam*, would ultimately agree that the prohibition on the registration of immoral or scandalous matter is also unconstitutional.<sup>10</sup> The Government appears to agree with this assessment. (See **Exhibit 16.**)

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<sup>10</sup> Notably, all of the judges in the *Fox* panel ultimately joined the majority in the *Tam en banc* decision.



#### 2.2.4. Section 2(a) Violates the “Unconstitutional Conditions” Doctrine

Under the unconstitutional conditions doctrine, the Government may not condition the availability of a government benefit on an individual's agreement to surrender a constitutional right. See *Home Ins. Co. of New York v. Morse*, 87 U.S. 445, 451 (1871); *Doyle v. Continental Ins. Co.*, 94 U.S. 535, 543 (1876); *Rumsfeld v. Forum for Academic & Institutional Rights*, 547 U.S. 47 (2006). Trademark registration is designed to provide government benefits to trademark registrants. See *In re McGinley*, 660 F.2d 481, 486 n.12 (1981) (“What is denied are the benefits provided by the Lanham Act which enhance the value of a mark”). As a viewpoint-based restriction on protected speech, § 2(a) violates this doctrine. See *In re Tam*, 2015 U.S. App. LEXIS 22593, \*80.

A rejection or cancellation under § 2(a) deprives the mark owner of significant rights – and not just a pretty piece of paper from the USPTO. It deprives the owner of the right to fully enforce the mark and inarguably limits the owner's ability to enforce it, as well as other important statutory rights. The glib view that “well, you can still use it” is insufficient under the First Amendment, lacks a foundation in logic, and is more “immoral and scandalous” than any trademark. Analogies abound, but imagine if the federal government allowed public demonstrations on public land, and provided security and porta potties to all demonstrators – unless the banners at the demonstration used cuss words. Those shouting “I prefer not to be drafted” would get all of these benefits, but those shouting “Fuck the Draft” would not. The Federal Circuit drew a further analogy to the Copyright Office; it would be absurd to assert that the Government could properly refuse to register works because they were “immoral” or “scandalous.” (See *In re Tam*, 2015 U.S. App. LEXIS 22593 at \*77

(stating that “[t]his idea – that the government can control speech by denying the benefits of copyright registration to disfavored speech – is anathema to the First Amendment”).

Though trademarks are limited in their ability to be “distasteful,” at least compared to copyrightable works, the ones that are potentially “immoral” or “scandalous” still embody the notion that “one man’s vulgarity is another’s lyric.” See *Cohen v. California*, 403 U.S. 15, 25 (1971). Trademarks convey the kind of speech the First Amendment abides being circulated into the “marketplace of ideas;” trademark holders have financial incentives to make their name acceptable to the public, and the public has the power to reject those trademarks if it doesn’t like them. *Edenfield v. Fane*, 507 U.S. 761, 766-67 (1993) (discussing, in general, the incentive for sellers to attract certain buyers by educating them about a product and the buyer’s incentive to explore and compare products. “The commercial marketplace . . . provides a forum where ideas and information flourish. . . . [T]he speaker and the audience, not the government, assess the value of the information presented”). By imposing unconstitutional conditions to the registration and enforcement of “immoral and “scandalous” words, § 2(a) impermissibly infringes upon free speech and commercial expression.

Proponents of Section 2(a) routinely argue that the statute does not offend the First Amendment because it is merely government speech, or is merely a restriction on a government subsidy. These arguments were brought before the Federal Circuit in *In re Tam* and rejected. See *In re Tam*, 2015 U.S. App. LEXIS 22593 at \*60-61, 77-78. Regardless of what the Government wants to call it, Section 2(a) is a viewpoint-based restriction on protected speech that

conditions a substantial government benefit on the concession of a constitutional right.

### **2.2.5. Section 2(a) Fails to Promote Any Substantial Government Interest**

Under the First Amendment, the requirement of a substantial government interest “is not satisfied by mere speculation or conjecture; rather, a governmental body seeking to sustain a restriction on commercial speech must demonstrate that the harms it recites are real and that its restriction will in fact alleviate them to a material degree.” *Florida Bar v. Went for It, Inc.*, 515 U.S. at 628. Instead, trademarks can facilitate societal change by “providing a forum where ideas and information flourish.... [where] the audience, not the government, assess[es] the value of the information presented.” *Edenfield*, 507 U.S. at 1798. “Laws restricting commercial speech ... need only be tailored in a reasonable manner to serve a substantial state interest.” *Id.*; see also, *Bad Frog* 134 F.3d at 98. The PTO has not historically articulated any interest that can justify the existence of § 2(a), and no such interest is even conceivable.

#### **2.2.5.1. Discouraging the use of “immoral” or “scandalous” marks**

Section 2(a) is a viewpoint-based restriction on speech that the government finds “immoral.” The U.S. Supreme Court has stated in no uncertain terms that “[t]he fact that a State’s governing majority has traditionally viewed a particular practice as immoral is not a sufficient reason for upholding a law prohibiting the practice.” *Lawrence v. Texas*, 539 U.S. 558 (2003). While *Lawrence* dealt with an anti-sodomy law, its reasoning is just as applicable to § 2(a); the PTO cannot use “morality” to justify the selective restriction and

governmental discouragement of protected speech on the basis of its content or message. The *In re Tam* court made such a finding in concluding that “§ 2(a) immediately fails at this step [showing a substantial government interest].” *In re Tam*, 2015 U.S. App. LEXIS 22593 at \*80.

The registration and operation of trademarks does not implicate more valid concerns such as the privacy or physical safety of consumers, either. The court in *Florida Bar v. Went for It, Inc.* accepted the government's interest in protecting individuals' privacy as a reason to uphold a 30-day solicitation ban for personal injury attorneys because the attorneys had a business incentive to seek out persons who had been in accidents. This interest in privacy was sufficient to sustain a restriction on commercial speech. The general consuming public, however, has a choice to purchase from the trademark holder, and the mere registration of an “offensive” trademark can in no way invade the privacy of individuals, just as a jacket stating “fuck the draft” does not invade the privacy of people in a public space. See *Cohen*, 403 U.S. 15. Rather, consumers have a greater ability to “avoid further bombardment of their sensibilities” by not only “simply averting their eyes,” but by denying a certain company their business. *Id.* at 21.

A “short, though regular, journey from mail box to trash can” has been found to be an acceptable burden under the Constitution. *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 72 (1983). In *Bolger*, the Court held that the intrusion of mail for contraceptives into one's home was acceptable and could not be constitutionally banned. How, then, could the registration of an “immoral” or “scandalous” display in an advertisement or a storefront be so invasive as to justify a restraint on protected speech? Indeed, today we have an even greater ability to avert our eyes from “offensive” material. For instance,

there are numerous television channels and radio stations to choose from, certainly more than in the 1970s. During the time of the *FCC v. Pacifica* case, courts may have had a stronger rationale to limit indecent speech, but even that case upheld rights under the First Amendment. *FCC v. Pacifica Found.*, 438 U.S. 729, 745–46 (1978) (“Indeed, if it is the speaker’s opinion that gives offense, that consequence is a reason for according it constitutional protection. For it is a central tenet of the First Amendment that the government must remain neutral in the marketplace of ideas.”). Avoiding going to an offensive store, searching for them on the Internet, or even having to change the channel is not a significant burden the court need relieve the public of.

#### **2.2.5.2. Occupying the “time, services, and use of funds of the federal government”**

Courts have previously attempted to justify § 2(a) under the reasoning that this provision reflects “a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government.” *McGinley*, 660 F.2d at 486. This reasoning has been repudiated. See *In re Tam*, 2015 U.S. App. LEXIS 22593 at \*75-76.

Even if the supposed rationale of “resource scarcity” happened to be sufficient justification for the restrictions on protected speech created by § 2(a), the supposed cost-saving purpose of this provision has never been borne out by reality. “The government expends few resources registering these marks.” *Id.* at \*81. Meanwhile, the time and consideration it takes to determine whether a mark is “immoral” or “scandalous” is burdensome on the PTO, the courts, and mark owners. Opinions on issues of morality change almost daily and also depend on geography, a trait that § 2(a) shares with determinations on whether

speech is “obscene.”<sup>11</sup> Thus, a determination of “immorality” or “scandalousness” under § 2(a) is not one that can easily be made based on “history, consensus, and simple common sense.” *Florida Bar*, 515 U.S. at 628.

The *In re Tam* court recognized how disingenuous this purported justification is. It found that “labeling this sort of interest as substantial creates an end-run around the unconstitutional conditions doctrine, as virtually all government benefits involve the resources of the federal government in a similar sense. Nearly every government act could be justified under this ground, no matter how minimal.” *In re Tam*, 2015 U.S. App. LEXIS at \*81-82.

Further, “a prohibition that makes only a minute contribution to the advancement of a state interest can hardly be considered to have advanced the interest to a material degree.” *Bad Frog*, 134 F.3d at 99. Thus, even if § 2(a) did manage to net the PTO some small savings, this would be insufficient to justify the Section’s existence, as the “spending . . . is attenuated from the benefits bestowed by registration.” *Id.* at \*76.

### **2.2.5.3. Trademarks are not government speech**

Another overruled government interest in § 2(a) has been that § 2(a) prevents the public from assuming that the PTO approves of “immoral” trademarks. See *In re McGinley*, 660 F.2d at 844. It is not government speech. See *In re Tam*, 2015 U.S. App. LEXIS 22593, \*53. The regalia of a registration certificate and the ® symbol does not turn a trademark into government speech; these are ministerial acts. See *id.* at \*52-53. The government does not have any issue archiving copyrightable works that many find distasteful. This is not colonial England, where citizens had to receive permits to publish their

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<sup>11</sup> While obscene speech is not afforded protection under the First Amendment, it is difficult to conceive of a trademark that could be considered legally obscene by today’s common community standards. See *Miller v. California*, 413 U.S. 15 (1973).

speech. People do not assume that someone can say something only with the government's consent and approval. The same logic applies to the conferral of government benefits for purposes that are wholly unrelated to the content of the benefited speech.

Moreover, the PTO explicitly denies any approval of the message conveyed by a trademark. See *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1219–20 (“the act of registration is not a government imprimatur or pronouncement that the mark is a ‘good’ one in an aesthetic, or any analogous, sense”). Further, just as “the mere presumed presence of unwitting listeners or viewers does not serve automatically to justify curtailing all speech capable of giving offense” (*Cohen*, 403 U.S. at 21), the mere presumed presence of people who erroneously consider trademark registration as a government stamp of approval does not justify curtailing all possibly “immoral” or “scandalous” speech.

### **2.3. Section 2(a) is Void for Vagueness and Cannot Be Enforced**

Section 2(a) is unconstitutionally vague. See *In re Tam*, 2015 U.S. App. LEXIS 22593, \*89 (O'Malley, J., concurring). The multitude of inconsistent § 2(a) cases show that § 2(a) does not convey “sufficiently definite warning as to the proscribed conduct when measured by common understanding and practices,” as required by the Constitution. *Roth v. United State*, 354 U.S. 467, 491 (1957). In applying § 2(a), “[t]he determination that a mark comprises scandalous matter is a conclusion of law based upon underlying factual inquiries.” *In re Mavety Media Group*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). In his concurrence, Judge O'Malley observed:

the law is by no means precise enough to enable the PTO and the courts to apply it fairly. As the majority points out, the Board has

allowed use of a term by one trademark holder while disallowing use of precisely the same term by another based apparently on its view of how use of that term might be received by the audience the Board has chosen to "identify." This fact alone evidences the absence of explicit standards for the application of 2(a).

*In re Tam*, 2015 U.S. App. LEXIS 22593, \*102 (internal citations and quotation omitted). In *In re Mavety*, the court noted that analysis for trademark refusal requires the opinions of a "substantial composite of the general public, the context of the relevant marketplace, or contemporary attitudes." *Id.* at 1373. Additionally, the court stated, "we must be mindful of ever-changing social attitudes and sensitivities." *Id.* at 1371.<sup>12</sup> This standard is similar to the standard for assessing obscenity, but addresses protected speech. *Cf. Miller v. California*, 413 U.S. 15 (1973). The Supreme Court has used obscenity law to show that speech enjoys full First Amendment protection where it does not fall under unprotected or significantly less protected categories of speech. See *Cohen v. California*, 403 U.S. at 20. Though *McGinley* rejected that analysis, *In re Tam*'s rejection of *McGinley* brings that analysis to bear.

To prove that a mark is scandalous, one "must demonstrate that the mark is 'shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; giving offense to the conscience or moral feelings; or calling out for condemnation,'" but "a showing that a mark is vulgar is sufficient to establish

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<sup>12</sup> This admonishment to "keep up with the times" was offered to argue for a more liberal interpretation of previously "immoral" marks. However, consider the converse. A word that has no non-innocent meaning at all can, through cultural shifts, become one that will at least draw laughter, if not scorn. For example, consider the shifting meaning of the word "tea bag." When used as a noun, as it has been for decades, there is no likely concern. However, the verb has a very different meaning. Would a mark that once contained this term be subject to later revocation? Section 2(a) also fails to give appropriate warning if the standard changes. In the past, certain marks like "Redskins" was not seen as offensive, or at least there was no action that could correct the issue. Now we see that the PTO can revoke a mark after it has been issued with no § 2(a) objection. The trademark holder thus has to worry both that the mark will be denied under § 2(a) during initial filing and that the mark could be revoked at any later date for a § 2(a) conflict.



that it consists of or comprises immoral or scandalous matter within the meaning of section 1052(a).” *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012). This standard is said to be “determined from the standpoint of a substantial composite of the general public, and in the context of contemporary attitudes.” *Id.*; *In re Boulevard*, 334 F.3d 1336 (Fed. Cir. 2003). However, in reality it is very often determined by the personal sensibilities of a single examining attorney or a few objecting persons. See, e.g., *In re Tam*, Brief of ACLU, Appeal No. 2014-1293 at 4 (June 19, 2015) (comparing the denial of “Uppity Negro” Application No. 86,053,392 with registration of Application No. 78,312,525); *In re Boulevard*, 334 F.3d at 1341 (“[A] number of declarations from academics and business persons . . . attested that the term was not offensive. Those declarations, however, consist mainly of the personal opinions of the declarants.”). The examples of the use of “Cock” in registered marks demonstrates this imprecise, inconsistent, and vague application. Courts’ recognition that the offensive character of marks changes with time in itself declares § 2(a) void for vagueness.

And this imprecision is far from innocent. The chilling effect of the vagaries of Section 2(a) are all too apparent, as recognized by the *In re Tam* court. The possibility of refusal of registration or cancellation of a registered mark means that

the § 2(a) bar on registration creates a strong disincentive to choose a ‘disparaging’ mark. And that disincentive is not cabined to a clearly understandable range of expression . . . . The uncertainty as to what *might be deemed* disparaging is not only evident on its face, given the subjective-reaction element and shifting usages in different parts of society. It is confirmed by the record of PTO grants and denials over the years, from which the public would have a hard time drawing much reliable guidance.”

*In re Tam*, 2015 U.S. App. LEXIS 22593 at \*40-41. There is no question that applicants will and do shy away from marks that may, one day, be considered

“immoral” or “scandalous” by either the PTO or some subset of the population that might not even purchase the applicant’s goods or services. This “contributes significantly to the chilling effect on speech.” *Id.* at \*44.

### 3.0 CONCLUSION

The PTO cannot suppress trademarks without also suppressing the ideas they convey. See *Cohen*, 403 U.S. at 26. Trademarks provide information to potential and current consumers, ranging from information about goods and services to company values, beliefs, and ideas. Therefore, § 2(a)’s restriction on “immoral . . . or scandalous matter; or matter which may disparage” suppresses the protected speech encompassed by trademarks without adequate justification. While an unsuccessful trademark applicant may indeed continue to use a mark refused or revoked on § 2(a) grounds, the value of that mark is hobbled and unenforceable, thereby making it less attractive and causing applicants to self-censor their use of potentially “immoral” or “scandalous” marks. This discourages such speech from the marketplace of ideas, favoring only individually approved speech and refuses significant enforcement rights. The First Amendment will not abide such arbitrary standards for the burdening of speech with unconstitutional conditions. It does not advance any substantial government interest, and is not narrowly tailored to serve any interest the government ever has, or ever could, put forth to justify it.

The Federal Circuit has spoken on this issue. It has struck down *In re McGinley*, the very foundation of case law upholding Section 2(a). As per the *In re Tam* court’s holding, there is no meaningful distinction between marks that are “disparaging” and those that are “immoral” and “scandalous.” The PTO has recognized the similarity of these provisions, as well. (See **Exhibit 16.**)

Though Applicant does not believe "Cock control" to be immoral or scandalous, either in general or in the relevant marketplace, this is ultimately irrelevant; Section 2(a) is no more. Not only is the prohibition on disparaging marks invalid, so is the prohibition on so-called immoral or scandalous matter. It is unconstitutional and has done great harm to the marketplace of ideas for decades. Therefore, Applicant requests that the mark "COCK CONTROL" proceed to registration immediately, as the comment period is over, nobody objected, and the only impediment to it – a belated 2(a) rejection – no longer has any legal justification.

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Respectfully Submitted,

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